

REMARKS

The foregoing amendments and the following remarks are responsive to the Office Action mailed January 20, 2004. Applicants respectfully request reconsideration of the present application.

Claims 1-61 are pending. Claims 1, 21, and 41 have been amended. Claim 5 has been cancelled. New claims 62 has been added. Therefore, claims 1-4 and 6-62 are presented for examination.

Examiner rejected claims 1-5, 9-12, 17-18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,628,325 issued to Steinberg, et al. in view of U.S. Publication No. 2003/0135681 issued to Laity, et al.

Steinberg discusses a "communication device" designed to be coupled to a camera, which in turn couples the camera to a network or a remote computer. (Steinberg, Abstract). Steinberg's process is as follows. The communication device is connected to a camera, and to a destination device, such as a computer. The communication device enables the downloading and/or manipulation of the images on the camera. However, Steinberg does not discuss the method of creating a connection between the camera and the host system. Furthermore, Steinberg does not teach or suggest presenting the digital camera device as a file server to the host device.

The Examiner refers to Steinberg, column 10, lines 62-64 to show "determining communication information allowing communication between the camera and the host device." The referenced section of Steinberg discusses that the communication device is programmed to query the camera communication port to determine if a camera is connected. This is not equivalent to determining communication information, or more

particularly, the communication protocol, which permits communication between the camera and the host device.

The Examiner refers to Steinberg, column 2, lines 47-48, and column 9, line 16, to show presenting the digital camera device as a file server to the host device. Column 2, lines 47-48 of Steinberg discuss the various types of ports that may be used, for connection to the digital camera. Column 9, line 16 notes that details aren't described. However, Steinberg does not teach or suggest presenting the digital camera device as a file server to the host device. Neither of the portions pointed to by the Examiner address this aspect of communications. Furthermore, Steinberg specifically teaches away from this, by stating that "It is a further object of the present invention to provide an apparatus enabling a user of a conventional digital camera designed to only download directly to a PC, to send camera data directly from the camera to a communication network for transmission and downloading to a remote network location or remote computer." (Steinberg, column 1, line 50-55). Thus, the digital camera is designed only to download directly to a PC, rather than to act as a file server.

The Examiner also notes that Steinberg does not teach or suggest "automatically identifying the particular host device to which the digital camera has been connected." For this feature, the Examiner uses Laity. Laity discusses a computer port expansion. The Examiner points to paragraph 2 of Laity, which notes that USB plug-and-play devices are well known in the art. While Applicants concur that plug-and-play devices are known in the art, plug-and-play is not equivalent in any way to "automatically identifying the particular host device that the digital camera is currently connected to." Plug-and-play devices use a standard protocol, when you attach a new hardware device to the computer and boot up, the operating system will detect the new hardware and install it, sometimes requiring some

additional information about the device which must be given by the user. This is not equivalent in any way to identifying the host device.

Claim 1, as amended, recites in part "automatically identifying the particular host device that the digital camera device is currently connected to, including determining communication information allowing communication between the digital camera device and the particular host device; based on said determined communication information, establishing a communication session between the digital camera device and the particular host device, said communication session supporting photo-serving communication protocols that present the digital camera device as a file server to the host device." As discussed above, neither Steinberg nor Laity teach or suggest a camera automatically identifying the host device the camera is connected to, nor presenting the camera as a file server to the host device. Therefore, claim 1, and claims 2-20 which depend on it, are not obvious over Steinberg in view of Laity.

The Examiner further added the following references, in rejecting the dependent claims: Examiner rejected claim 6 under 35 U.S.C. §103(a) as being unpatentable over Steinberg, et al. in view of Laity, et al. and further in view of U.S. Patent No. 6,535,243 issued to Tullis, et al. Examiner rejected claims 7-8, 16 under 35 U.S.C. §103(a) as being unpatentable over Steinberg in view of Laity and further in view of U.S. Publication No. 2003/0142215 issued to Ward, et al. Examiner rejected claims 13-15 under 35 U.S.C. §103(a) as being unpatentable over Steinberg, et al. in view of Laity, et al. and further in view of U.S. Patent No. 5,737,491 issued to Allen, et al. Examiner rejected claims 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over Steinberg, et al. in view of Laity, et al. and further in view of U.S. Patent No. 6,148,354 issued to Ban, et al. None of the

references cited by the Examiner remedy the shortcomings of Steinberg and Laity.

Therefore, claims 1-20 are not obvious over the references cited.

Examiner rejected claims 21-25, 29-32, 37-40 under 35 U.S.C. §103(a) as being unpatentable over Steinberg, et al. in view of U.S. Patent No. 6,148,354 issued to Ban, et al. Ban discusses an architecture for a USB based PC flash disk. The Examiner points to column 1, line 66 to column 2, line 1, for the feature of “automatically identifying the particular host device that the portable device is connected to, including determining communication information allowing communication between the portable device and the particular host device.” However, the portion of Ban specifically notes that “peripheral devices are self-identifying.” (Ban, column 1, line 66). This means that the host device identifies the peripheral, in Ban. This is quite different from the portable device identifying the host. Ban does not teach or suggest the portable device identifying the host. Similarly, with respect to uploading driver, Ban teaches that “the host platform often uploads a USB client driver.” (Ban, column 9, line 2). Ban does not teach or suggest the portable device uploading a driver to the host, as is claimed in claim 21.

Firstly, Applicants respectfully submit that there is no suggestion within the references themselves for the combination suggested by the Examiner. Since Steinberg specifically teaches away from such a combination, by providing a pre-defined communication device which is coupled to the portable device, therefore ensuring that the host's identity is always known, and identical, there is no motivation to include discovery of the host's identity into Steinberg.

Furthermore, even in combination, Steinberg and Ban do not make the present invention obvious. Claim 21, as amended, recites:

A method for providing a variety of disparate host devices access to files residing on a portable device, upon the portable device's connection to one of the host devices, the method comprising:

automatically identifying the particular host device that the portable device is connected to, including determining communication information allowing communication between the portable device and the particular host device; and based on said determined communication information:

(1) establishing a communication session between the portable device and the particular host device, said communication session supporting file-serving communication protocols that present the portable device as a file server to the host device; and

(2) if needed by the host for supporting said file-serving communication protocols, automatically uploading a driver from the portable device to the particular host device and thereafter invoking execution of the driver at the particular host device, for providing host-side support for said file-serving communication protocols. Examiner rejected claim 26 under 35 U.S.C. §103(a) as being unpatentable over

(Claim 21). Neither Ban nor Steinberg teach or suggest automatically uploading a driver from the portable device to the particular host device, as discussed above.

Therefore, claim 21, and claims 22-40 which depend on it, are not obvious over Steinberg in view of Ban.

The Examiner further added the following references, in rejecting the dependent claims: The Examiner rejected claims over Steinberg, et al. in view of U.S. Patent No. 6,148,354 issued to Ban, et al. and further in view of U.S. Patent No. 6,535,243 issued to Tullis, et al. Examiner rejected claims 27-28, 36 under 35 U.S.C. §103(a) as being unpatentable over Steinberg, et al. in view of U.S. Patent No. 6,148,354 issued to Ban, et al. and further in view of U.S. Publication No. 2003/0142215 issued to Ward, et al. Examiner rejected claims 33-35 under 35 U.S.C. §103(a) as being unpatentable over Steinberg, et al. in view of U.S. Patent No. 6,148,354 issued to Ban, et al. and further in view of U.S. Patent No. 5,737,491 issued to Allen, et al. None of the references cited by the Examiner remedy the shortcomings of Steinberg and Ban, discussed above. Therefore, claims 21-41 are not obvious over the references cited.

Examiner rejected claims 41, 43-45, 51, 59 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,005,613 issued to Endsley, et al. in view of Ban, et al.

Endsley discusses a multi-mode digital camera, which transfers captured images to a host computer. Endsley discusses the connection between the computer and the host device by stating "The USB hardware and software provides communication between the host 12 and the camera 10 through the aforementioned abstraction called a "pipe." This is the quote to which the Examiner refers, suggesting that the plug-and-play features of USB are equivalent to automatically identifying the particular host device that the portable device is connected to. However, as Applicants have noted above, USB plug-and-play enables the host device to identify the portable device, not vice versa. Discovery of the identity of the host device is not taught or suggested by Endsley. As discussed above, Ban also does not teach or suggest identifying the host device.

Claim 42 recites:

A portable device allowing a variety of disparate host devices access to files residing on the portable device, upon the portable device's connection to one of the host devices, the portable device comprising:

a connection interface for enabling the connection of the portable device to a particular host device that is capable of hosting the portable device;

an identification module for automatically identifying the particular host device that the portable device is connected to, including determining communication information allowing communication between the portable device and the particular host device;

a communication module for establishing a communication session between the portable device and the particular host device, wherein said communication session supports file-serving communication protocols that present the portable device as a file server to the host device.

(Claim 42, as amended). As discussed above, the references do not teach or suggest automatically identifying the particular host device that the portable device is connected to, as recited in claim 42. Therefore, claim 42, and claims 43-63 which depend on it, are not obvious over nor anticipated by Endsley in view of Ban.

The Examiner further added the following references, in rejecting the dependent claims: Examiner rejected claims 42, 49-50, 52, 57-58 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,005,613 issued to Endsley, et al. in view of Ban, et al. and further in view of Steinberg, et al. Examiner rejected claim 46 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,005,613 issued to Endsley, et al. in view of U.S. Patent No. 6,148,354 issued to Ban, et al. and further in view of U.S. Patent No. 6,535,243 issued to Tullis, et al. Examiner rejected claims 47-48, 56, 61 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,005,613 issued to Endsley, et al. in view of U.S. Patent No. 6,148,354 issued to Ban, et al. and further in view of U.S. Publication No. 2003/0142215 issued to Ward, et al. Examiner rejected claims 53-55 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,005,613 issued to Endsley, et al. in view of U.S. Patent No. 6,148,354 issued to Ban, et al. and further in view of U.S. Patent No. 5,737,491 issued to Allen, et al. Examiner rejected claim 60 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,005,613 issued to Endsley, et al. in view of U.S. Patent No. 6,148,354 issued to Ban, et al. and further in view of U.S. Patent No. 6,529,969 issued to Inoue. None of the references cited by the Examiner remedy the shortcomings of Endsley and Ban. Therefore, claims 41-63 are not obvious over the references cited.

In view of the foregoing amendments and remarks, Applicants respectfully submit that all pending claims are in condition for allowance. Such allowance is respectfully requested.


If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to contact Judith A. Szepesi at (408) 720-8598.

If there are any additional charges, please charge Deposit Account No. 02-2666.

Respectfully submitted,

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